

Applicant : Dimitri Azar
Serial No. : 10/627,943
Filed : July 25, 2003
Page : 2 of 3

Attorney's Docket No.: 00633-030002 / 00/037D

REMARKS

Applicant submits that there has been a misapplication of the law of inherency. A rejection based on inherency requires:

1. a claim that recites elements A, B, and C,
2. a reference that discloses A and B, and
3. some showing that given A and B, it is *inevitable* that C is also present.

Only if these three conditions are met is a rejection based on inherency proper. If there exists a possibility that A and B can coexist without C, then a rejection based on inherency is improper.

As support for the above interpretation of the law, Applicant draws attention to MPEP 2112 (IV), which discusses the law of inherency. For example, the Federal Circuit has stated that

To establish inherency, the extrinsic evidence "must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill"... "Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." *In re Robertson*, 169 F.3d 743 (Fed. Cir. 1999).

The Board of Appeals has also stated that

"In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art" *Ex parte Levy*, 17 USPQ 2d 1461, 1464 (Bd. Pat. App. & Inter. 1990)[emphasis in original]

In the case now before the Office:

- A and B are the actuator and the intraocular lens,
- C is the union of the controller and rangefinder.

Applicant : Dimitri Azar
Serial No. : 10/627,943
Filed : July 25, 2003
Page : 3 of 3

Attorney's Docket No.: 00633-030002 / 00/037D

The Office concedes that *Grendahl* teaches only A and B. In rejecting the claim based on inherency, the Office must show that the existence of a controller and rangefinder in *Grendahl* is an *inevitable consequence* of the existence of the lens and the actuator.

Applicant draws attention to a counter-example that disproves this. There exists the possibility, as disclosed by *Grendahl* itself,¹ that the wearer will manually adjust the focus by simply pressing on the eyeball in much the same way one might adjust a contact lens.

The existence of this counter-example makes it logically impossible to prove that C *necessarily* follows from A and B. Since the law requires that C *necessarily* flow from A and B, the present rejection is improper. Applicant therefore requests that the Office consider that possibility that it has inadvertently misapplied the law of inherency on these facts.

Please apply any other charges or credits to deposit account 06-1050.

Respectfully submitted,

Date: April 13, 2005


Faustino A. Lichauco
Reg. No. 41,942

Fish & Richardson P.C.
225 Franklin Street
Boston, MA 02110-2804
Telephone: (617) 542-5070
Facsimile: (617) 542-8906
21067175.doc

¹ Grendahl, col. 3, lines 10-15.